

RREMARKS

Claims 1-14 are pending, claims 1 and 14 having been rejected. The indication of allowable subject matter with respect to claims 2-13 is appreciated.

Claims 1 and 14 were rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Sturm et al. (US 5,260,800) in view of National Semiconductor's Video Sync Separator LM1881 data sheet. The Applicant respectfully traverses this rejection for the following reason(s).

Claim 1

Claim 1 is **defined as** a video signal processing integrated circuit for use in a video recording/reproducing apparatus, *the video signal processing integrated circuit comprising, as a single chip . . .*

Sturm fails to teach or suggest such a single chip video signal processing integrated circuit, and the Examiner has failed to identify where such a single chip is taught by Sturm. The National Semiconductor data sheet fails to suggest that the video signal processing components of Sturm be disposed on a single chip.

It has long been an accepted practice in the PTO to have the preamble give meaning to the claim and properly define the invention, *Gerber Garment Technology, Inc. v. Lectra Systems, Inc.*, 916 F.2d 683, 16 USPQ 2d 1436, 1441 (Fed. Cir. 1990).

Clearly the preamble to Applicant's claim 1 not only defines the invention, but also gives

meaning to the claim.

Accordingly, the rejection of claim 1 is deemed to be in error and should be withdrawn.

Additionally, claim 1 calls for, in part, *a video recording/reproducing processor for providing a video signal to be recorded on a storage medium and for reproducing a video signal recorded on said storage medium.*

Here the Examiner relies only on the teachings in Sturm, and refers to col. 3, lines 8-9.

Sturm's invention relates to video technology and to video tape duplication. More particularly, Sturm's invention relates to a system for duplication of video programs from a laser disk master to a video cassette at a speed that is a multiple of the normal playback speed of the laser disk master. See col. 1, lines 9-16.

Sturm's col. 3, lines 6-9 refer to "an apparatus and method are provided for utilizing a laser video disk master operating at twice speed for duplicating video information to be recorded in VHS format."

There is no mention in lines 8-9 of a *video recording/reproducing processor*. Considering col. 3, lines 8-9 in conjunction with all that is taught by Sturm, and in particular, col. 1, lines 9-16, there is only a teaching of a master laser video disk that is to be played at twice its normal playing speed in order for the video information to be duplicated on a video cassette in VHS format.

Accordingly, the rejection of claim 1 is deemed to be in error and should be withdrawn.

Next, claim 1 calls for *a composite synchronization dividing unit for separating a composite*

synchronization signal from a video signal output by said video recording/reproducing processor.

Here the Examiner Sturm's col. 7, lines 1-8, which state:

"The output of video buffer 90 is connected to the input of sync separator 92. Sync separator 92 may be an LM 1881 sync separator integrated circuit, available from National Semiconductor Corp. of Sunnyvale, Calif. Its function is to isolate the sync pulses from the composite video signal. The voltage waveform at the output of sync separator 92 is shown as trace "B" in FIG. 3b."

Note that Sturm's *composite synchronization dividing unit* is connected to the output of video buffer 90, and video buffer 90 has not been deemed to correspond to, and does not correspond to, the claimed *video recording/reproducing processor*.

FIG. 3a is an expanded block diagram of the write clock generator 90 shown in FIG. 2. Video buffer 90 is a component of write clock generator 90, neither of which have the functions of *providing a video signal to be recorded on a storage medium and reproducing a video signal recorded on said storage medium*.

Note also, that the video buffer 90 receives the composite video signal from FM demodulator 56 on line 72, however, the FM demodulator 56 also fails to have the functions of *providing a video signal to be recorded on a storage medium and reproducing a video signal recorded on said storage medium*.

Therefore, Sturm's *composite synchronization dividing unit* does not have the whole function of *separating a composite synchronization signal from a video signal output by said video recording/reproducing processor*.

Accordingly, the rejection of claim 1 is deemed to be in error and should be withdrawn.

Next, claim 1 calls for *a vertical synchronization dividing unit for separating a vertical synchronization signal from the composite synchronization signal*.

Here the Examiner notes that Sturm does not disclose such a *vertical synchronization dividing unit*, and relies on the National Semiconductor data sheet which teaches that the LM 1881 used by Sturm has separated vertical sync output in response to an input composite video signal.

Note that contrary to the Examiner's assertion, the LM1881 does not output a separated horizontal sync signal, but instead additionally outputs a composite sync signal and a burst/back porch output..

In Sturm, the burst/back porch output of sync separator 92 is applied to burst oscillator 97.

The other output of Sturm's sync separator 92 is the voltage waveform at the is shown as trace "B" in FIG. 3b.

Here it must be noted that the voltage waveform at the output of sync separator 92, shown as trace "B" in FIG. 3b, is a pulse corresponding to the position of the horizontal sync signal in signal "A" of FIG. 3b. However, the LM1881 does not output a separated horizontal sync signal, so it must be concluded that the voltage waveform at the output of sync separator 92, shown as trace "B" in FIG. 3b, is the composite sync signal. There is no circuit shown that receives this composite sync signal to separate the vertical sync signal therefrom.

Accordingly, there is no showing in Sturm that the vertical sync signal output terminal of the LM1881 is connected to any of the other components in Sturm's invention. Therefore, it is deemed that the vertical sync signal is not separated from the composite synchronization signal.

Accordingly, the rejection of claim 1 is deemed to be in error and should be withdrawn.

Claim 1 then calls for *a quasi vertical synchronization inserting unit for inserting a quasi vertical synchronization signal in the video signal output from said video recording/reproducing processor.*

Here the Examiner refers to Sturm's col. 3, lines 33-37. As noted above, Sturm fails to teach *a video recording/reproducing processor.*

Sturm's col. 3, lines 33-37 state:

The demodulated 2X video information is converted to digital information by an analog to digital (A/D) converter. The 2X digital video information is then time-base corrected and drop out compensated. New sync and blanking signals in digital form are switched into or mixed with the digitized video signal and digital color-under chroma processing and digital luminance noise reduction processing are performed.

There is only mention of new digital sync and blanking signals, with no specific mention of a quasi vertical sync signal, and these digital signals are mixed with the digitized video signal.

Accordingly, these digital signals are not inserted into any video signal output from what ever component the Examiner deems to correspond to the claimed *video recording/reproducing processor*, noting that the claimed *video recording/reproducing processor* must have both the functions of *providing a video signal to be recorded on a storage medium and reproducing a video signal recorded on said storage medium.*

As the former Court of Customs and Patent Appeals held: It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ

391, 393 (CCPA 1965); see also *In re Mercer*, 515 F.2d 1161, 1165-66, 185 USPQ 774, 778 (CCPA 1975).

Accordingly, the rejection of claim 1 is deemed to be in error and should be withdrawn.

Also, claim 1 calls for *a single pin port for outputting the vertical synchronization signal from said video signal processing integrated circuit and inputting a quasi vertical synchronization signal to said video signal processing integrated circuit.*

Here the Examiner refers to Sturms col. 12, lines 14-23 and notes that Sturm is silent with respect to a sync circuit with a bidirectional pin. Thereafter, the Examiner takes "Official Notice" that integration of features and processes into compact, multi-purpose devices is common practice, widely known, and commercially available, in holding that it would have been obvious to modify Sturm in order to provide a single bidirectional sync signal pin.

The Examiner does not explain why such a pin would have been necessary in Sturm, nor how it would have been utilized and located in Sturm.

That a prior art device could be modified to produce the claimed device does not justify an obviousness rejection unless the prior art suggested the modification's desirability. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Therefore we hold that the taking of Official Notice is deficient, and request the Examiner identify which component is being deemed to correspond to the claimed **single chip video signal processing integrated circuit comprising**, where the *pin port* is located and where it is suggested that such a port have both functions of *outputting the vertical synchronization signal and inputting a*

quasi vertical synchronization signal.

Accordingly, the rejection of claim 1 is deemed to be in error and should be withdrawn.

Further, claim 1 calls for *a switching unit for providing the vertical synchronization signal, which is input from the vertical synchronization dividing unit, to the pin port, or providing the quasi vertical synchronization signal, which is input from the pin port, to the quasi vertical synchronization inserting unit.*

The Examiner has not addressed this feature of claim 1, and thus fails to establish a *prima facie* basis of obviousness.

Accordingly, the rejection of claim 1 is deemed to be in error and should be withdrawn.

Claim 14

Claim 14 is drawn towards a method for designing a video signal processing integrated circuit having a recording and reproducing processor for modulating/demodulating a video signal, a vertical synchronization dividing unit, and a quasi vertical synchronization inserting unit.

Claim 14 calls for the method to comprise *forming a single pin port for outputting a vertical synchronization signal separated from a composite synchronous signal by said a vertical synchronization dividing unit and for inputting to said video signal processing integrated circuit a quasi vertical synchronization signal produced by a microprocessor.*

Here the Examiner refers to Sturms col. 12, lines 14-23 and notes that Sturm is silent with respect to a sync circuit with a bidirectional pin. Thereafter, the Examiner takes "Official Notice"

that integration of features and processes into compact, multi-purpose devices is common practice, widely known, and commercially available, in holding that it would have been obvious to modify Sturm in order to provide a single bidirectional sync signal pin.

The Examiner does not explain why such a pin would have been necessary in Sturm, nor how it would have been utilized and located in Sturm.

That a prior art device could be modified to produce the claimed device does not justify an obviousness rejection unless the prior art suggested the modification's desirability. *In re Gordon*, supra.

Therefore we hold that the taking of Official Notice is deficient, and request the Examiner identify why such a *pin port* is necessary in Sturm, where the *pin port* is to be located and where it is suggested that such a port have both functions of *outputting the vertical synchronization signal and inputting a quasi vertical synchronization signal*.

Accordingly, the rejection of claim 14 is deemed to be in error and should be withdrawn.

Further, claim 14 calls for the method to comprise *designing the pin port to operate as an input port for inputting said quasi vertical synchronization signal in a special reproducing mode, and to operate as an output port for outputting the vertical synchronization signal to the microprocessor in all other modes of said video signal processing integrated circuit*.


The Examiner has not addressed this feature of claim 14, and thus fails to establish a *prima facie* basis of obviousness.

Accordingly, the rejection of claim 14 is deemed to be in error and should be withdrawn.

The Examiner is respectfully requested to reconsider the application, withdraw the objections and/or rejections and pass the application to issue in view of the above amendments and/or remarks.

Should a Petition for extension of time be required with the filing of this Response, the Commissioner is kindly requested to treat this paragraph as such a request and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of the incurred fee if, **and only if**, a petition for extension of time be required **and** a check of the requisite amount is not enclosed.

Respectfully submitted,



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